

REMARKS

The amendment to Claim 5 seeks to further clarify the scope of the claimed embodiment.

In the prosecution above the claims were rejected under Section 112 said to have failed to comply with the enablement requirement in respect to the disclosed branching agent recited in Claim 1. The relevant claim recitation reads:

“a branching agent selected from a second group consisting of tri-functional phenolic monomer and tetra-functional phenolic monomer said agent containing at least one functional amine group capable of polymerization.”

In rejecting the claims the Examiner erroneously construed the recited phenolic monomers as requiring the presence of three (or four) phenolic groups. Contrary to the Examiner's reading, the adjective “tri-functional” modifies the term “monomer” ; It does not modify “phenolic”. That the monomers in question do not carry phenolic functionalities exclusively is clear. Isatinbiscresol that contain one amine and two phenolic functionalities is therefore clearly within the scope of the description, is enabled and is in fact exemplified.

The rejection alleging lack of enablement is believed erroneous.

Claims 5 and 7 were rejected under 35 U.S.C. 112 second paragraph alleged to be indefinite. As presently amended Claim 5 is believed clearer as to its scope.

As explained above in respect to enablement, the Isatinbiscresol , the structure of which is correctly comprehended by the Examiner is correctly dependent from Claim 1.

Claims 1,3-7, 10-13, 15-19 and 21-25 were rejected in the prosecution above under 35 U.S.C. 102(b) as anticipated by or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 6,423,766 to Itagaki (Itagaki).

Itagaki disclosed a flame retardant composition that contains an optionally branched polycarbonate, a rubbery graft copolymer that is "prepared by grafting a composite rubber with one or more vinyl monomers", a phosphoric ester and polytetrafluoroethylene.

The standard for anticipation is one of strict identity. To anticipate a claim for a patent, a single prior art document must contain all the essential elements of the claimed invention. Set against this standard Itagaki cannot reasonably be said to anticipate the claimed invention wherein poly(ester)carbonate component(s) are branched and where the graft copolymer is required to be based on other than polybutadiene.

The rejection alleging anticipation is clearly untenable.

Itagaki disclosed branching of the included polycarbonate a mere optional feature and evidently recognized no difference between linear and branched resins in the context of his invention. In contrast the present invention is predicated at least in part on the finding of surprising and unexpected advantages attributed to branched resins. While Itagaki disclosed butadiene-free graft it failed to disclose or suggest compositions that contain both branched poly(ester)carbonate and the butadiene free graft, compositions that exhibit surprising and unexpected ESC behavior. (see comparative Examples V1 and V2 in the table on page 25)

The experimental evidence shows the inventive composition to exhibit better ESC behavior than do corresponding compositions wherein polycarbonate is linear.

The Examiner's pointing to that Itagaki's graft is butadiene-free does not appear to be presently material.

Claims 8-10 were rejected in the prosecution above under 35 U.S.C. 103(a) as obvious over Itagaki in view of U.S. Patent 4,185,009 to Idel (Idel).

Idel disclosed branched polycarbonate. As the Examiner is certain to know, the mere mention of components of the invention in diverse documents does not make their combination legally tenable. In the absence of a reason to combine, the rejection based on the combination is legally lacking. Yet even if legally valid, the experimental evidence discussed above would serve to rebut and overcome the rejection.

Consideration of the above upon the examination of the application is requested.

Respectfully submitted,

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